

REMARKS

Claims 14-25, 28-34 and 35 are present in this application. Claims 15, 18, 19, 24, 25, 28, and 31-33 have been improperly withdrawn from consideration based upon the improper Restriction Requirement dated July 28, 2008, that did not demonstrate the required showing of a lack of "unity of invention." Claims 26 and 27 were previously canceled without prejudice or disclaimer. Claims 14, 16, 34 and 35 have been amended to correct minor informalities without introducing any new matter and without any change of scope requiring a new search. Accordingly, the present amendments to claims 14, 16, 34, and 35 should be entered.

SUMMARY OF THE OFFICE ACTION

The outstanding Office Action is an improper final Action that acknowledges the claim for priority but fails to acknowledge that copies of the certified copies of the priority documents have been received from the International Bureau.

In addition, the outstanding Action presents an improper rejection of claims 34 and 35 under 35 U.S.C. §101, an improper rejection of claims 14, 16, 17, 20-23, 29, 30, and 34 under the second paragraph of 35 U.S.C. §112, and an improper rejection of claims 14, 16, 17, 20-23, 29, 30, 34, and 35 under 35 U.S.C. §103(a) as being unpatentable over Ishiguro (U.S. Patent No. 7,216,368).

FOREIGN PRIORITY

As noted above, the U.S.P.T.O. has failed to properly acknowledge that copies of the certified copies of the priority documents have been received from the International Bureau. Correction of this oversight is respectfully requested.

IMPROPER OFFICE ACTION SUMMARY

The Office Action Summary fails to acknowledge that claims 14-25 and 28-35 are pending in this application with claims 15, 18, 19, 24, 25, 28, and 31-33 being improperly withdrawn from consideration. Claim 35 is further missing from the list of claims being rejected.

WITHDRAWAL OF IMPROPER OFFICE ACTION

The outstanding Action is clearly improper in being made final while failing to answer the traverse of the Restriction Requirement dated July 28, 2008, that noted that this Restriction Requirement improperly applied the criteria of distinctness from MPEP § 800 instead of the "unity of invention" criteria required by MPEP § 1893.03(d) and 37 C.F.R. § 1.475. This matter is further treated in the Petition filed under 37 C.F.R. § 1.144 for withdrawal of this improper requirement that is filed herewith. In addition, this outstanding Action should be withdrawn because it improperly denies consideration of claims 15, 18, 19, 24, 25, 28, and 31-33 based upon an improper Restriction Requirement as noted in this Petition for withdrawal of the improper Restriction Requirement.

35 U.S.C. §101 REJECTION

Item 8 on page 3 of the outstanding Action is followed by a paragraph that sets forth the above-noted rejection of claims 34 and 35 under 35 U.S.C. §101. This rejection is traversed.

The paragraph at the bottom of page 3 of the outstanding Action first clearly erroneously states that claims 34 and 35 "are directed to an '*accounting system*'" even though it is specifically noted that exemplary claim 34 in fact "recites a computer-readable recording medium physically recording thereon a computer program for controlling an accounting system." Clearly an "*accounting system*" is not the same thing as a "computer-readable medium" even if that "computer-readable medium" has a computer program recorded on it that is for "controlling an accounting system."

The above-noted first clearly erroneous statement is followed by a second clearly erroneous statement alleging that the claim 34 recited "computer-readable medium" is in some further unexplained way being interpreted to be "merely software." However, this interpretation is clearly contrary to the express provision of claim 34 (and also that of claim 35) that the computer program must be physically recorded on a "computer-readable recording medium." While the Examiner cites MPEP § 2106.01 at the bottom of page 3 of the outstanding Action as somehow supporting this clearly erroneous allegation that "merely software" is being claimed,

this section contradicts this by noting that “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”

Thus, it could not be clearer that claims 34 and 35 are drawn to computer readable media (articles of manufacture) that contain programs that will control the computer reading these media (and, thus, defined by MPEP § 2106.01 to be “functional descriptive material”). Such claims directed to computer implemented programs that that are recorded on a “computer-readable medium system” clearly satisfy both MPEP § 2106.01 and 35 U.S.C. §101 as being articles of manufacture. Consequently, this rejection of claims 34 and 35 under 35 U.S.C. §101 is completely without merit and should be withdrawn.

35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Item 10 on page 3 of the outstanding Action sets forth the above-noted rejection of claims 14, 16, 17, 20-23, 29, 30, and 34 under the second paragraph of 35 U.S.C. §112 that improperly alleges that these claims are indefinite as being “generally narrative” and failing to conform to U.S. practice.

This reasoning was traversed as to the previous rejection of claims 14, 16, 20, 22, and 23 on this same ground (claim 26 having been canceled) by noting that:

[C]laims 14, 16, 20, 22, 23, and 26 are all simply asserted to be indefinite as being “generally narrative” and “failing to conform with current U.S. practice.” However, these mere conclusions are not explained with any particularity as to any exemplary claim language that is considered to be “generally narrative” and there is no explanation of what constitutes “current U.S. practice,” much less any examples presented as to how any particular claim language is contrary to this undefined “current U.S. practice.”

The outstanding Action violates MPEP § 707.07(f) that requires that as the Examiner has repeated this rejection as to claims 14, 16, 20, 22, and 23, this previous argument against the rejection of these claims is to noted and the Examiner is to “answer the substance of it.”

Claim 14 is further improperly alleged to be claiming a method step as to the recitation that “the accounting server is structurally arranged to compare the accounting amount to a

remaining amount of money information corresponding to the received accounting ID” and “when the remaining amount of money information corresponding to the received accounting ID is larger than the accounting amount the accounting server subtracts the accounting amount from the remaining amount of money information corresponding to the received accounting ID and returns an indication of a successful accounting result to the license server that upon receipt of the indication of the successful accounting result determines that the decoding information corresponding to the content ID will be provided to the content reproduction device through the communication network so that the content reproduction device then performs decoding with the stored decoding information each time the particular encrypted content is selected to be decoded for reproduction.”

Once again, the outstanding Action violates MPEP § 707.07(f) that requires that as the Examiner has repeated this rejection as to claim 14, the previous argument against this clearly erroneous “method step” rationale is required to be answered. In this regard, there is no answer presented in the outstanding Action to the following previously presented points:

In addition, it is well established and recognized by MPEP §2173.01 that:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. (Emphasis added.)

Further in this regard, MPEP §2173.02 states that:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable

degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

To whatever extent that the Examiner is again seeking to require the use of some unidentified “current U.S. practice,” and is again seeking to avoid the required analysis of the rejected claims and associated required setting forth of **reasons** why these rejected claims do not meet the threshold requirements of clarity and precision required by the statute, the outstanding Action again commits clear error. In other words, it is clearly arbitrary and capricious to simply conclude that some undefined standard of “current U.S. practice” has not been met or that, based on some undefined criteria, the Examiner can interpret the clearly functional recitations noted from claims 14, 21, and 23 to be “method steps.”

Further in this last regard, and as also noted in the last response, it is clear that the language noted in the outstanding Action is not in any expressly stated “method” or “step” language as appeared in the decisions the Examiner cites. Instead, this noted language from claims 14, 21, and 23 clearly relates to recitations of functions. With further regard to such **functional language**, this type of claim language is noted to be proper for use in an apparatus claim in terms of being noted to comply with the second paragraph of 35 U.S.C. §112 in MPEP §2173.05(g) that notes that:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

In any event, the above noted failure to follow MPEP § 707.07(f) dictates the withdrawal of this incomplete Action and its finality.

In addition, as the rationales offered in support of the rejection of claims 14, 16, 17, 20-23, 29, 30, and 34 under the second paragraph of 35 U.S.C. §112 are clearly based on unsubstantiated conclusions that interpret clearly functional recitations to be method steps, the withdrawal of this rejection is clearly in order.

35 U.S.C. §103 REJECTION

Item 18 on page 6 of the outstanding Action sets forth the above-noted rejection of claims 14, 16, 17, 20-23, 29, 30, 34, and 35 under 35 U.S.C. §103(a) as being unpatentable over Ishiguro. This rejection is traversed.

Item 19 on page 6 of the outstanding Action sets forth three bulleted allegations as to the teachings of Ishiguro and the alleged subject matter of claims 14, 16, 34, and 35.

Turning to the subject matter of claim 14, and as noted in the last response, the presence of a license server connected with an accounting server and a content server (apparently being read as the claimed content reproduction device) by a communication network (disclosed to be the INTERNET) is certainly taught by FIG. 1 of Ishiguro as alleged relative to the bulleted points.

However, and as further specifically noted in the last response, all that col. 7, lines 47-64 (that include relied upon lines 50-60) teach is that the client 1 is provided with content from the content server 3 and not that any “decoding information” is supplied to a content reproduction device “that is structurally arranged to read out an accounting ID identifying money information from a prepaid card, to transmit a content ID identifying a desired encrypted content and the accounting ID to the license server through a communication network” as specified by claim 14.

While at least desired content is identified by the user at the client 1 and sent to a server (not the license server), there is no providing of accounting ID identifying money information by the user and certainly none due to reading this accounting ID identifying money information from “a prepaid card.” There is also no disclosure that “the license server is structurally arranged to receive the content ID and the accounting ID from the content reproduction device and to transmit an accounting amount obtained from the received content ID and the accounting ID to the accounting server.” There is further no hint here that what is returned to the content reproduction device is decoding information needed to decode the desired encrypted information from the license server when the license server determines that decoding information can be provided to the content reproduction device that is stored so that the content reproduction device can “then perform decoding with the stored selected decoding information each time the particular encrypted content is selected to be decoded for reproduction.”

Also, and as set forth in the last response, claim 14 requires the accounting server to perform in a manner completely different from the way the accounting server 5 of Ishiguro performs. See col. 11 lines 34-47, noting the performance of accounting receiver 5 as follows:

In step S103, the CPU 21 of the license server 4 gains access to the accounting server 5 through the communication unit 29 and requests the accounting server to perform a credit authorization process regarding the user corresponding to the user ID and password. Given the credit authorization request from the license server 4 over the Internet 2, the accounting server 5 examines the payment history or other suitable records of the user defined by the user ID and password. A check is made illustratively to see if the user in question has failed to pay the price of any license in the past. If the user is not judged to have such nonpayment records, the accounting server 5 transmits credit authorization data; if the user is judged to have any nonpayment records, the accounting server 5 transmits credit rejection data.

Even though the above-noted arguments as to the rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Ishiguro were expressly set forth in the last response, the outstanding Action again violates MPEP § 707.07(f) by not answering these arguments or the argument of the last response noting that MPEP §2143.03 directs examiners to consider all claim limitations in an obviousness analysis, even those asserted to be indefinite. Accordingly, the withdrawal of this incomplete Action and its improper finality are again required.

Moreover, as no *prima facie* case of obviousness has been established as to the improper rejection of claims 14, 16, 17, 20-23, 29, 30, 34, and 35 under 35 U.S.C. §103(a) as being unpatentable over Ishiguro that also relies on ignoring and misreading express claim limitations, withdrawal of this improper rejection is respectfully submitted to be clearly in order.

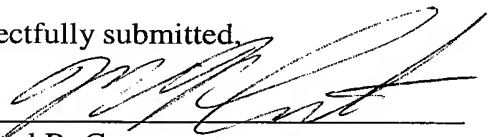
CONCLUSION

Should there be any outstanding matters that need to be resolved as to the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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